

Serial No.: 10/730,440
Office Action Date: 11/17/2004

Filed: 12/8/2003
Amendment Date: 12/15/2004

REMARKS/ARGUMENTS

In response to the Office Action mailed 11/17/2004, Applicant respectfully traverses the restriction/election requirement as further set forth below. Additionally, a preliminary amendment is hereby submitted amending claims 23-25 and 32.

The subject Office Action alleges that the application contains claims directed to four patentably distinct species of claims and identifies these four species with reference to the four groupings of figures as follows: Species I – FIGS. 2, 2A and 3; Species II – FIG. 4; Species III – FIG. 5; Species IV – FIGS. 6 and 7. The Office Action alleged that no claims are generic.

As an initial matter, Applicant points out FIGS. 2A and 7 illustrate exemplary, alternative embodiments of linear to rotary translation elements of the invention. Similarly, FIGS. 3, 4, 5 illustrate exemplary, alternative embodiments of damping mechanisms of the invention. FIG. 2 illustrates an exemplary combination of the embodiments of the damping mechanism of FIG. 3 and the linear to rotary translation elements of FIG. 2A. FIG. 6 illustrates an exemplary combination of the embodiments of the damping mechanism of FIG. 4 and the linear to rotary translation elements of FIG. 7. Other alternative combinations of the various illustrated embodiments of the damping mechanism (FIGS. 3, 4 and 5) and the linear to rotary translation elements (FIGS. 2A and 7) are not, however, illustrated in separate combination figures. These other combinations include the exemplary, alternative embodiments of combined figures as follows: FIGS. 2A and 4; FIGS. 2A and 5; FIGS. 7 and 3; and FIGS. 7 and 5. Hence the alleged species sets I-IV do not fully comprehend all combination of linear to rotary translation elements and damping mechanisms of the various figures and as claimed. In fact, the alleged species II and III do not independently comprehend a complete invention as disclosed and claimed in the present application in as much as both only comprehend the damping mechanism of the invention without any linear to rotary translation elements. Applicant therefore does not know how to interpret the

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species II and III and does not consider them to be validly alleged species– are the alleged species II and III to correspond to only one, either, both or none of the exemplary, alternative embodiments of linear to rotary translation elements?

A proper restriction requires that two or more independent and distinct inventions be claimed in the subject application. **35 USC 121**. The Office Action has failed to provide any support for the restriction requirement and has hence failed to provide a prima facie case for restriction. The Office action has failed to provide (1) reasons why the inventions as claimed are distinct and (2) any explanation why the distinct inventions must be restricted (e.g. separate classification, common classification/separate status, or different field of search). **MPEP 808.02**.

Applicant's support prosecution of all claims and alleged species together in the present application. The Allegation that no claims are generic is not supported. At least claims 1, 6 and 11 are generic to any combinations (species) of the various illustrated embodiments of the damping mechanism (FIGS. 3, 4 and 5) and the linear to rotary translation elements (FIGS. 2A and 7) as described above. All three claims 1, 6 and 11 recite limitations found in all of the validly alleged species (i.e. are not mutually exclusive) – and in those other combination of linear to rotary translation elements and damping mechanisms not separately referred to as species in the Office Action. **MPEP 806.04(f)**. Furthermore, the invention is directed toward linear to rotary damping devices having controllable damping characteristics through variable viscosity fluids. This does not suggest an unreasonable burden in search or examination.

Applicant hereby provisionally elects species corresponding to the species group identified as Species I in the Office Action (FIGS. 2, 2A and 3). The claims readable thereon include claims 1-4, 6-9, 11-14, 16, 18, 20-23, 25-27 and 29-32. Also, in the event that Applicant's traversal is not accepted, Applicant retains the right to present any non-provisionally elected claims in a divisional application.

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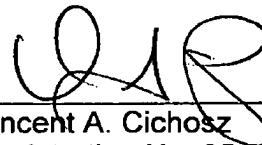
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Based on the above, it is respectfully submitted that the restriction requirement is improper and Applicant respectfully requests withdrawal thereof and prosecution of all claims 1-33 to proceed on the merits.

If the Examiner has any questions regarding the contents of the present response he may contact Applicants' attorney at the phone number appearing below.

Respectfully submitted,



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